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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,156	12/30/1999	PETER M. BONUTTI	BON-4687	7407

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EXAMINER

CHANNAVAJJALA, SRIRAMA T

ART UNIT PAPER NUMBER

2177

DATE MAILED: 07/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/476,156

Applicant(s)

BONUTTI, PETER M.

Examiner

Srirama Channavajjala

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawing filed on 12/30/1999 is approved by the Draftsperson under 37 CFR 1.84 or 1.152 .
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show
3. every feature of the invention specified in the claims, at least flow chart(s) or diagrams, for example, disseminating information relating to litigation pending in a plurality of courts of law, periodically reviewing records in a plurality of courts of law, obtain data relating to lawsuits filed in each of the plurality of courts of law, transmitting the data obtained from the records in each court of law of the plurality of courts of law to a database, accessing the database with terminals, communicate with the database by a network, transmitting at least a portion of the data from the database over the network..... , must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Information Disclosure Statement

4. The information disclosure statement filed on 1/19/2000, paper no. # 4, has been considered and a copy was enclosed with this office action, paper no. # 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8, 14, 18-35, 37-49, 51-59, are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones, Steven et al., [hereafter Jones], WO 97/41524 in view of Bennett et al., [hereafter Bennett], US Patent No. 5444615.

6. As to Claims 1, 47, Jones teaches a system which including 'information relating to litigation' [page 3, line 21-24], Jones is directed to caseload management, more specifically automated litigation management as detailed in page 3, line 21-26, 'transmitting the data obtained from the records' [page 3, line 28-31, page 4, line 1-2], Jones specifically teaches various databases, for example new cases DB, fig 2, transmitting new claims in response to the entry of data into the source new claim database to central processing unit as detailed in fig 2, 'accessing the database with terminals which communicate with the database by a network' [fig 2, page 9, line 26-31],

'transmitting at least a portion of the data from the database over the network to the terminals which access the database' [fig 2, page 5, line 19-26]. However, Jones does not specifically teach 'periodically reviewing records in a plurality of courts of law to obtain data relating to lawsuits'. On the other hand, Bennett et al. disclosed the aforementioned limitation 'periodically reviewing records in a plurality of courts of law to obtain data relating to lawsuits' [col 10, line 41-65, col 14, line 59-63], plurality of court of law corresponds to state and federal laws as detailed in col 5, line 19-20

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Bennett et al. into the legal claims processing system for caseload management of Jones because they are both directed to litigation management, more specifically Jones is directed to caseload management managing litigation [see Abstract], while Bennett is directed to case law information selecting from the categories or subcategories of law [see Abstract, col 3, line 11-14], and are both from the same field of endeavor. One of ordinary skill in the art at the time of the invention would have been motivated to combined the references because that would have allowed users of Jones to interactively control which relative combination of individual categories or subcategories of law that related to litigations satisfies his or her needs as suggested by Bennett [col 3, line 3-8].

7. As to Claim 2, 48, Bennett teaches a system which including 'reviewing records in a plurality of courts of law.....'[col 5, line 18-22], plurality of court of law corresponds

to state and federal laws as detailed in col 5, line 19-20, 'the identity of the defendant, and the cause of action for each of the lawsuits filed in the plurality of courts of law' [col 5, line 38-43], 'transmitting data obtained from the records in each court of law of the' [col 3, line 24-26], Bennett suggests to use transcription network that is connected to attorney's terminals, see fig 2-3, 'identity of the defendant and the cause of action for each of lawsuits.....'[col 5, line 40-49].

8. As to Claims 3, 5, 37, 51-52, Bennett teaches a system which including 'reviewing records in a plurality of courts of law.....'[col 5, line 18-22], plurality of court of law corresponds to state and federal laws as detailed in col 5, line 19-20, 'transmitting data obtained from the records in each court of law.....'[col 3, line 24-26, col 27, line 30-31, col 28, line 1-4].

9. As to Claims 4, 49, Bennett teaches a system which including 'reviewing records in a plurality of courts of law determining the identity of the attorney or attorneys filling lawsuits.....'[see fig 1-3, col 5, line 18-21, element 4, element 21], 'transmitting data obtained from the records in each court of law.....'[col 3, line 24-26, col 6, line 27-34, col 27, line 30-31, col 28, line 1-4].

10. - As to Claim 6, Bennett teaches a system which including 'searching the database to determine the disposition of lawsuits filed by any one attorney in each court of

law.....'[see Abstract, col 5, line 13-30], 'transmitting at least a portion of the data from the database to the terminals'[col 10, line 41-61].

11. As to Claims 7, 40, 46, 53, 58, the limitation of this claim has been noted in the rejection of Claim 1 above. In addition, Bennett disclosed 'manually copying records in each court of law.....'[col 12, line 60-66, col 18, line 11-15].

12. As to Claim 8, the limitation of this claim has been noted in the rejection of Claim 1, above. In addition, Bennett disclosed 'electronically transmitting data to a data storage device' [col 11, line 35-48].

13. As to Claims 14, 24-25 the limitation of this claim has been noted in the rejection of Claim 1, above. In addition, Jones teaches 'law firm represented defendants.....' [fig 15B, fig 17], Jones specifically teaches assigning subscriber to a specific law firm.

14. As to Claim 21, the limitation of this claim has been noted in the rejection of Claim 1 above, in addition, Bennett teaches 'determining the average length of time lawsuits filed by one attorney.....'[col 10, line 62-67]

15. As to Claims 22-23, 30-32, the limitation of this claim has been noted in the rejection of claim 1 above, in addition, Bennett teaches lower court, higher court [see col 5, line 19-21].

Art Unit: 2177

16. As to Claims 26-27, the limitation of this claim has been noted in the rejection of claim 1 above, in addition, Maxwell teaches 'determining a relationship between a number of lawsuits which were appealed from each judge of a plurality of judges.....'[table XXVII, one of the field name is judge], Maxwell also teaches various relational tables linked.

17. As to Claims 28-29, the limitation of this claim has been noted in the rejection of claim 1 above, in addition, Maxwell teaches 'expert witness for each cause of action.....'[col 3, line 55-56].

18. As to Claims 33-34, Jones teaches a system which including 'information relating to litigation' [page 3, line 21-24], Jones is directed to caseload management, more specifically automated litigation management as detailed in page 3, line 21-26, 'transmitting data relating to all lawsuits' [page 3, line 28-31, page 4, line 1-2, line 24-28], Jones specifically teaches various databases, for example new cases DB, fig 2, transmitting new claims in response to the entry of data into the source new claim database to central processing unit as detailed in fig 2, transmitting the request and activity response related to litigation, 'accessing the database with terminals which communicate with the database by a network' [fig 2, page 9, line 26-31], 'transmitting at least a portion of the data relating to the lawsuits from the database to the terminals which access the database' [fig 2, page 5, line 19-26], examiner interpreting lawsuits corresponds to litigation, more specifically managing automated litigation management

Art Unit: 2177

over network as detailed in page 4, line 21-24 However, Jones does not specifically teach 'lawsuits filed within a period of time in each of a plurality of courts of law'. On the other hand, Bennett et al. disclosed the aforementioned limitation 'lawsuits filed within a period of time in each of a plurality of courts of law' [col 10, line 41-65, col 14, line 59-63], Bennett suggests identifying dates and times of specific evidence references that may be related to case, plurality of court of law corresponds to state and federal laws as detailed in col 5, line 19-20.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Bennett et al. into the legal claims processing system for caseload management of Jones because they are both directed to litigation management, more specifically Jones is directed to caseload management managing litigation [see Abstract], while Bennett is directed to case law information selecting from the categories or subcategories of law [see Abstract, col 3, line 11-14], and are both from the same field of endeavor. One of ordinary skill in the art at the time of the invention would have been motivated to combined the references because that would have allowed users of Jones to interactively control which relative combination of individual categories or subcategories of law that related to litigations, further specifically identify dates and times that the evidence of lawsuits filed satisfies his or her needs as suggested by Bennett [col 3, line 3-8, col 10, line 41-52].

As to Claim 35, the limitation of this claim has been noted in the rejection of Claim 33-34 above, in addition, Bennett teaches 'identity of the attorney or attorneys filing each of the lawsuits' [see fig 1-3].

19. As to Claims 38, 44, 59, the limitation of this claim has been noted in the rejection of Claim 33-34, in addition, Bennett teaches transmitting data relating to both federal and state courts' [col 5, line 16-21].

20. As to Claims 39,45, 57, the limitation of this claim has been noted in the rejection of Claim 33-34, in addition, both Jones, Bennett teach 'database includes electronically reading electronically transmitting data [see Jones: Abstract, fig 1-2; Bennett: fig 1-3].

21. As to Claim 41, Jones teaches a system which including 'information relating to litigation' [page 3, line 21-24], Jones is directed to caseload management, more specifically automated litigation management as detailed in page 3, line 21-26, 'transmitting data to a database identifying the parties to lawsuits' [page 3, line 28-31, page 4, line 1-2, line 11-13], Jones specifically teaches various databases, for example new cases DB, fig 2, transmitting new claims in response to the entry of data into the source new claim database to central processing unit as detailed in fig 2, lawsuits corresponds to litigation 'accessing the database with terminals which communicate with the database by a network' [fig 2, page 9, line 26-31], 'transmitting at least a portion of the data from the database to the terminals which access the database' [fig 2,

Art Unit: 2177

page 5, line 19-26]. However, Jones does not specifically teach 'identifying the parties to lawsuits filed in a plurality of courts of law within a period of time, the attorney representing at least one of the parties'. On the other hand, Bennett et al. disclosed the aforementioned limitation "identifying the parties to lawsuits filed in a plurality of courts of law within a period of time, the attorney representing at least one of the parties" [col 5, line 34-43], plurality of court of law corresponds to state and federal laws as detailed in col 5, line 19-20, Bennett also teaches extracting information related cases for possible legal defenses as detailed in col 5, line 39-40.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Bennett et al. into the legal claims processing system for caseload management of Jones because they are both directed to litigation management, more specifically Jones is directed to caseload management managing litigation [see Abstract], while Bennett is directed to case law information selecting from the categories or subcategories of law [see Abstract, col 3, line 11-14], and are both from the same field of endeavor. One of ordinary skill in the art at the time of the invention would have been motivated to combined the references because that would have allowed users of Jones to interactively identify and collect required information for representing a party or parties that related to litigations satisfies his or her needs as suggested by Bennett [col 3, line 3-8, col 10, line 41-52].

Art Unif: 2177

22. As to Claim 42, the limitation of this claim has been noted in the rejection of Claim 41, in addition, Bennett teaches 'status of all lawsuits pending' [col 24, line 65-67, col 25, line 1-4].

23. As to Claim 43, the limitation of this claim has been noted in the rejection of Claim 41, in addition, Bennett teaches 'identifying the judges to whom each of the lawsuits pending...' [col 25, line 36-41].

24. As to Claims 54-56, Jones teaches a system which including 'information relating to litigation' [page 3, line 21-24], Jones is directed to caseload management, more specifically automated litigation management as detailed in page 3, line 21-26, 'transmitting data relating to all lawsuits' [page 3, line 28-31, page 4, line 1-2, line 24-28], Jones specifically teaches various databases, for example new cases DB, fig 2, transmitting new claims in response to the entry of data into the source new claim database to central processing unit as detailed in fig 2, transmitting the request and activity response related to litigation, 'accessing the database with terminals which communicate with the database by a network' [fig 2, page 9, line 26-31], 'transmitting data from the database to the terminals' [fig 2, page 5, line 19-26], examiner interpreting lawsuits corresponds to litigation, more specifically managing automated litigation management over network as detailed in page 4, line 21-24 However, Jones does not specifically teach 'lawsuits filed within a period of time in each of a plurality of courts of law, identifying all exert witnesses'. On the other hand, Bennett et al. disclosed the

Art Unit: 2177

forementioned limitation 'lawsuits filed within a period of time in each of a plurality of courts of law' [col 10, line 41-65, col 14, line 59-63], Bennett suggests identifying dates and times of specific evidence references that may be related to case, plurality of court of law corresponds to state and federal laws as detailed in col 5, line 19-20, 'identifying expert witnesses' [col 9, line 38-42].

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Bennett et al. into the legal claims processing system for caseload management of Jones because they are both directed to litigation management, more specifically Jones is directed to caseload management managing litigation [see Abstract], while Bennett is directed to case law information selecting from the categories or subcategories of law [see Abstract, col 3, line 11-14], and are both from the same field of endeavor. One of ordinary skill in the art at the time of the invention would have been motivated to combined the references because that would have allowed users of Jones to interactively control which relative combination of individual categories or subcategories of law that related to litigations, further specifically identifying expert witnesses that related to specific case satisfies his or her needs as suggested by Bennett [col 3, line 3-8, col 10, line 41-52, col 9, line 11-13].

25. Claims 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al., [hereafter Bennett], US Patent No. 5444615 in view of T.J. Becker, 'On-line Justice, Research Horizons, last updated on June 30, 1998 [4 pages]..

26. As to Claims 60-61, Bennett teaches a system which including 'litigation in a plurality of courts of law' [col 2, line 35-39, col 5, line 16-21], 'transmitting data relating to all lawsuits filed within a period of time in each of a plurality of courts of law to a database' [col 10, line 41-65, col 14, line 59-63], Bennett suggests identifying dates and times of specific evidence references that may be related to case, plurality of court of law corresponds to state and federal laws as detailed in col 5, line 19-20, 'accessing the database with terminals which communicate with the database by a network' [col 3, line 36-52], database corresponds to fig 1, element 43,63,91-92, 'transmitting data from the database to the terminals' [col 7, line 42-60]. However, Bennett does not specifically teach 'criminal lawsuits filed', 'identifying all individuals charged with having committed a crime and crime with which the individual is charged with having committed'. On the other hand, Becker suggests in the 'On-line Justice' article Georgia crime information center or GCIC maintains an electronic database that focuses on sentencing and disposition, further it is connected to the TCP/IP network [see page 1, second paragraph], further the new database contains juvenile court one for state and superior courts, also tracks each docketed case based on docket number or the names of the individuals involved as detailed in page 2 paragraph three.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Becker into attorney terminal having outline preparation capabilities for managing trial proceeding of Bennett et al. because they are both directed to lawsuit management issues, more specifically Bennett is directed to

Art Unit: 2177

case law information selecting from the categories or subcategories of law [see Abstract, col 3, line 11-14], while Becker is directed to on-line justice using information technology and telecommunication laboratory having TCP/IP network, database used by court judges and clerks anywhere they have internet access [see page 1, first paragraph] and are both from the same field of endeavor. One of ordinary skill in the art at the time of the invention would have been motivated to combined the references because that would have allowed users of Bennett to interactively transmit and receive complete records of individual criminal case history, further allows to trac other lawsuits such as Civil suits in the state and superior court portion, revealing a complete listing of plaintiffs and defendants, bringing the advantages of having this data is the ability to see whether a particular individual is prone to involvement in lawsuits as suggested by Becker [page 2, paragraph seven].

27. Claims 9-13,15-17,36,50, are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones, Steven et al., [hereafter Jones], WO 97/41524, Bennett et al., [hereafter Bennett], US Patent No. 5444615, as applied to Claims 1 above, and further in view of Maxwell, US Patent No. 6098070.

28. As to Claims 9-13 Jones, Bennett teaches a system which including 'transmitting data from the database to at least some of the terminals' [Jones: see fig 1-2; Bennett: col 11, line 35-48], Bennett teaches 'plurality of courts of law.....'[col 5, line 18-22], plurality of court of law corresponds to state and federal laws as detailed in col 5, line

Art Unit: 2177

19-20. However, both Jones, Bennett do not specifically teach 'relationship between a number corresponding to the number of lawsuits in which one attorney represented litigants in a plurality of courts of law and'. On the other hand, Maxwell disclosed the aforementioned limitation 'relationship between a number corresponding to the number of lawsuits in which one attorney represented litigants in a plurality of courts of law and'[col 18, line 45-51, table XXVI, XXVIII], Maxwell is directed to case management, more specifically relational database management in which several of tables have been shown for example table XXVI, XXVIII are created are attorney table structure, courts table structure respectively established relationship, for example linked by court ID field and like as detailed in col 18, line 43-44.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Maxwell into Attorney terminal having outline preparation capabilities for managing trial proceeding of Bennett et al. , the legal claims processing system for caseload management of Jones because they are case management system, more specifically Maxwell is directed to electronic case management using relational database having number of tables and a case management program for interfacing with a user to receive data [see Abstract, col 2, line 64-67], Jones is directed to caseload management managing litigation [see Abstract], while Bennett is directed to case law information selecting from the categories or subcategories of law [see Abstract, col 3, line 11-14], and are from the same field of endeavor. One of ordinary skill in the art at the time of the invention would have been

Art Unit: 2177

motivated to combined the references because that would have allowed users of Jones, Bennett to interactively control which relative combination of individual categories or subcategories of law, further establishing relationship between number of tables that related to not only litigations, defendants, insurers, expert witnesses, but also related cases in various courts and attorneys, bringing the advantages of electronic case management using relational database handling complex nature of case data as suggested by Maxwell [col 2, line 60-67].

29. As to Claim 15-17, 18-20, 36, 50, the limitation of this claim has been noted in the rejection of Claim 9-13 above. In addition, Maxwell teaches 'specific type of cause of action in which one attorney represented litigants.....'[fig 8-9, 5B], specific type of cause of action related to personal injury as detailed in fig 9, fig 5B, attorney representing litigants [see fig 8].

30. As to Claim 18-20, the limitation of this claim has been noted in the rejection of Claim 9-13, 15-17 above. In addition, Bennett teaches 'resulted in a decision by a judge or a jury' [col 10, line 15-24].

Conclusion

The prior art made of record

- a. WO 97/41524
- b. US Patent No. 5444615
- c. US Patent No. 6098070
- d. TJ Becker, On-line Justice, database provides bigger

picture for court officials, Research horizons [4 pages], last updated: June 30, 1998

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

- e. US Patent No. 6128620
- f. US Patent No. 6173284
- g. US Patent No. 5838966
- h. US Patent No. 5875431
- i. Joachim et al., dockets: a model for adding value to

content, www.sts.tu-harburg.de, pages: 15.

- j. www.inslawinc.com/techno, 4 pages.

- k. www.supremecourtus.gov/docket/docket.html,

September 21, 2001, one page.

- l. www.courtlink.com, 2 pages and

www.courts.net, 4 pages.

Art Unit: 2177

m. Electronic public access to court recordsx, Legal
technology institute, University of Florida, Levin College of Law, Fall 1999,
pages 1-43.

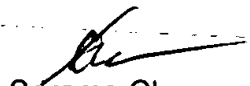
n. www.llrx.com 3 pages.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Srirama Channavajjala whose telephone number is (703) 308-8538. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:30 PM Eastern Time. The TC2100's Customer Service number is (703) 306-5631.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached on (703) 305-9790. The fax phone numbers for the organization where the application or proceeding is assigned are as follows:

703/746-7238	(After Final Communication)
703/746-7239	(Offical Communications)
703/746-7240	(For Status inquiries, draft communication)
(703) 308-6607	(Art Unit)

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.


Srirama Channavajjala
Patent Examiner.
July 12, 2002.